IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants:	Stewart et al.	Examiner:	Basehoar, Adam L.
Title:	System, method and recordable medium for printing services over a network and graphical user interface	Docket No.:	MIME-0003

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Commissioner for Patents
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REPLY BRIEF

Sir:

This paper is being filed in response to the Examiner's Answer dated 29 April 2011.

In the Grounds of Rejection section of the Examiner's Answer, the Examiner reiterates all rejections from the Final Office Action dated 22 June 2010. See, e.g., Examiner's Answer, pp. 4-18; Final Office Action, pp. 2-18. In response, Appellants maintain and reiterate all of the arguments presented in the Appeal Brief dated 4 February 2011.

In this Reply Brief, Appellants address new arguments presented by the new Examiner in the Response to Argument section of the Examiner's Answer.

I.   Rejection of claim 41 under 35 U.S.C. § 102(e)

As discussed in the Appeal Brief dated 4 February 2011, the Examiner fails to show that Tonkin discloses generating content for a display area that concurrently

includes a preview area, a navigation area, an estimate area, and a configuration area as claimed therein. Appellants maintain and reiterate all of the arguments presented in support of this contention in the Appeal Brief.

In the Response to Argument section of the Examiner's Answer, the Examiner again reiterates that windows are capable of being arranged by a user, and therefore concludes that Tonkin discloses the concurrent display of the three windows. Examiner's Answer, pp. 19-20. However, as previously noted by Appellants, Tonkin does not expressly disclose that the three windows are concurrently displayed, it would be desirable to concurrently display the windows, or that arrangement by a user so that they are concurrently displayed is desirable. In fact, the Examiner does not cite to any teaching of Tonkin in support of the Examiner's position. Furthermore, Tonkin expressly teaches that the various windows are presented in series, rather than concurrently, which the Examiner does not address. See, e.g., Appeal Brief, pp. 10-12.

Apparently seeking alternative support for the rejection, the Examiner proffers "that a reasonable interpretation/definition of the term 'concurrently' is 'acting in conjunction.' In view of this, clearly the multiple displayed windows of the graphical user interface of Tonkin are included concurrently with each other to provide the (sic) all of the claimed functionality." Examiner's Answer, p. 20.

In response, Appellants note that the grammatical construction of the relevant language of the claim renders the Examiner's proffered definition entirely unreasonable. Claim 41 reads, in relevant part, "generating content for a display area..., wherein the display area concurrently includes..." In the claim, 'concurrently' modifies the term 'includes,' which describes features of 'a display area.' Since 'concurrently' is used to

modify the term 'includes,' the proposed definition of 'acting in conjunction' makes no sense in this context. Rather, the Examiner merely attempts to isolate the term from its context in order to distort the plain meaning of the term to fit with a new theory to support a flawed rejection.

All other contentions of the Examiner regarding claim 41 in the Response to Argument section have been addressed in the arguments presented in the Appeal Brief. In light of the above, Appellants respectfully submit that the Examiner continues to fail to present a *prima facie* showing that Tonkin discloses not only all of the limitations claimed, but also all of the limitations arranged or combined in the same way as recited in claim 41. As a result, Appellants respectfully request reversal of the rejection of claim 41 as allegedly being anticipated by Tonkin.

II. Rejection of claims 37, 38, and 40 under 35 U.S.C. § 103(a)

A. Claim 37

As discussed in the Appeal Brief dated 4 February 2011, Appellants respectfully submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske teaches or suggests obtaining document information for a document on a server from system software executing on a client, where the system software is configured to enable a user of the client to use an application to request generation of a print file based on the document using the application, generate the print file on the client in response to the request without further user interaction, and initiate transmitting the print file to the server in response to the generation of the print file and without user-initiated interaction with the server as claimed therein. Appellants maintain

and reiterate all of the arguments presented in support of this contention in the Appeal Brief.

In the Response to Argument section of the Examiner's Answer, the Examiner alleges that Adamske discloses "generates and transmits a unique identifier for use by the system software [executing on the client]" and states in support thereof "creates a metafile... a 'file cabinet'... client-side print driver program... repository of electronic documents... previously uploaded by the user." Examiner's Answer, p. 21. Appellants are unable to determine the argument the Examiner is attempting to make by presenting the quoted snippets. Regardless, Appellants note that none of these snippets discloses generation of a unique identifier on a server and transmission of the unique identifier for use by system software executing on a client as in claim 37. For example, the "creates a metafile" is described as occurring on the client computer. Adamske, col. 6, lines 44-47. Similarly, Adamske's discussion of the 'file cabinet' merely describes a mechanism by which a user can access documents previously uploaded (Adamske, col. 7, lines 16-24), and is unrelated to the generation and transmission of a unique identifier for use by system software executing on a client.

Furthermore, the Examiner again relies on the previous BPAI decision in support of the allegation that the printable version of the file is created at the client in Adamske. Appellants have previously addressed this contention in the Appeal Brief, pp. 16-17, the substance of which the Examiner has not addressed.

The Examiner also alleges that Adamske does not require user-initiated interaction with a server since "[t]he user of the client software only interacts with the client software, the actual transmission of the file from the client to the server is done at

the user's request to the client software but the user has no actual interaction with the server (column 5, line 64-column 7, line 15 of Adamske)." Examiner's Answer, p. 22.

The Examiner apparently attempts to define 'interaction' as requiring some type of direct interaction with the server, without any intermediate software. Appellants do not agree with this contention. Regardless, claim 37 only discusses user-initiated interaction with the server, not user-implemented interaction with the server as discussed by the Examiner. As a result, the Examiner's contentions are not relevant to the analysis. In Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-17. In either of these approaches to uploading a document, the user must be aware of and explicitly designate an address that identifies the server (e.g., web address or email address) using the software. The web browser or email client uses the identifying information to upload the electronic document, and would take no action absent the user's request. In this manner, the user initiates the interaction with the server, regardless of whether such interaction is actually implemented by intermediate software, such as a web browser or email client.

All other contentions of the Examiner regarding claim 37 in the Response to Argument section have been addressed in the arguments presented in the Appeal Brief. In light of the above, Appellants respectfully request reversal of the rejections of claim 37, and claims 38, and 40, which depend therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske.

B. Claim 40

With further respect to claim 40, Appellants respectfully submit that the Examiner fails to show that Adamske teaches or suggests installing the system software on the client, wherein the system software includes at least one print driver for generating the print file on the client and an upload manager for communicating the print file from the client to the server as claimed therein. Appellants maintain and reiterate all of the arguments presented in support of this contention in the Appeal Brief.

In the Response to Argument section of the Examiner's Answer, the Examiner alleges that "Adamske discloses a method in which a print driver is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15: 'returns converted printable electronic document... to web server... print driver program... sends this metafile to translation server')." Examiner's Answer, p. 23. As these snippets describe the transmission of files, they do not directly support the Examiner's contention that Adamske discloses a print driver installed on a client in order to generate a print file as in claim 40.

Additionally, the Examiner does not include relevant portions of the discussion of Adamske, which results in the snippets presenting a false characterization of the teachings of the two embodiments of Adamske. For example, the Examiner does not include in the first two snippets that Adamske states that "**Application translation server 24 then** returns the converted printable electronic document... to web server." Adamske, col. 5, lines 64-66. Similarly, the Examiner does not include in the second two snippets that Adamske states that "**user 10 sends this** metafile to translation server 24." Adamske, col. 6, lines 49-51. As a result, the portions of Adamske cited by

the Examiner both describe something other than the print driver software program as transmitting documents. Furthermore, as previously argued, both embodiments of Adamske describe the printable electronic document as being generated by the application translation server. See, e.g., Adamske, col. 5, lines 15-19; col. 6, lines 49-52

All other contentions of the Examiner regarding claim 40 in the Response to Argument section have been addressed in the arguments presented in the Appeal Brief. In light of the above, Appellants again respectfully request reversal of the rejection of claim 40 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske.

III. Rejections of claims 12-16, 20-27, 31-36, 39, and 42 under 35 U.S.C. § 103(a)

A. Claim 12

All arguments of the Examiner regarding claim 12 in the Response to Argument section of the Examiner's Answer have been addressed in the arguments presented in the Appeal Brief. Appellants maintain and reiterate all of the arguments presented with respect to this claim in the Appeal Brief. In light of the above, Appellants respectfully request reversal of the rejections of claim 12, and claims 13-16 and 32-34, which depend therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

B. Claims 32 and 33

With further respect to claims 32 and 33, Appellants submit that the Examiner fails to show that the proposed combination of the two embodiments of Adamske and Tonkin teaches or suggests that the print file can be directly printed by a printer or that the print file comprises one of: a PostScript file and a Portable Document Format (PDF) file. Appellants maintain and reiterate all of the arguments presented in support of this contention in the Appeal Brief.

In the Response to Argument section of the Examiner's Answer, the Examiner states that "[w]hile not relied upon, the Tokin (sic) reference also teaches said feature (column 7, lines 11-27: "PDF... first convert them into a portable document format")." Examiner's Answer, p. 25. However, this discussion of Tonkin describes functionality of a processing facility, and not of system software for use on a client as in claims 32 and 33. In particular, Tonkin describes that "the various pages of the graphic user interface are provided from processing facility 60, preferably as HTML coded web pages." Tonkin, col. 6, lines 61-63. One such page enables a user to enter a source file, which is preferably a PDF document. Tonkin, col. 7, lines 11-18. "However, the present invention can be configured so as to accept source files in other formats... If such other formats are in fact allowed, it is preferable to first convert them into a portable document format..." Tonkin, col. 7, lines 19-25. As a result, Tonkin's discussion is unrelated to the system software for use on a client of claims 32 and 33.

All other contentions of the Examiner regarding claims 32 and 33 in the Response to Argument section have been addressed in the arguments presented in the Appeal Brief. In light of the above, Appellants again respectfully request reversal of the

rejections of claims 32 and 33 as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

C. Claim 13

With further respect to claim 13, in the Response to Argument section, the Examiner again selectively edits quoted passages of Adamske to present a false interpretation of its teachings. In particular, the Examiner states "print driver program can be downloaded on the client... conversion into a printable (e.g., Postscript) version". Examiner's Answer, p. 25. However, the Examiner leaves out that Adamske explicitly describes the conversion as being performed on the application translation server, which is clearly distinct form the print driver program downloaded on the client in Adamske. See, e.g., Adamske, col. 5, lines 15-19; col. 6, lines 49-52.

In light of the above, Appellants again respectfully request reversal of the rejections of claim 13 and claim 14, which depends therefrom, as allegedly being unpatentable over the proposed combination of the two embodiments of Adamske and Tonkin.

D. Claims 14, 20, 22, 24, 31, 39, and 42

All contentions of the Examiner regarding claims 14, 20, 22, 24, 31, 39, and 42 in the Response to Argument section have been addressed in the arguments presented in the Appeal Brief.

IV. Conclusion

In summary, Appellants submit that independent claims 24, 32, and 36 are allowable over the cited art because the Examiner's use of Adamske, Tonkin, and/or Grohs fails to present a *prima facie* showing that each element of the claimed inventions is taught or suggested by the cited art. Additionally, Appellants respectfully submit that all other pending claims are allowable over the cited art by, *inter alia*, dependency.

Respectfully submitted,

/John LaBatt/

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